

## II REMARKS

### 2.1 35 USC 112-2 REJECTIONS

#### 2.1.1 Introduction

The Applicant respectfully traverses the 35 USC 112, second paragraph ("112-2") rejection for the reasons set forth in Section 2.1.2 et seq.

#### 2.1.2 The 35 USC 112-2 Rejections Do Not Establish

##### A Prima Facie Case

The 35 USC 112-2 rejection does not approach the specificity required to establish a prima facie case and to inform the Applicant of the nature of the rejection as required by 35 USC 132.<sup>1</sup>

Various examples of the non-specific and uninformative nature of the instant rejection are as follows.

a. The rejection does not provide acceptable evidence or reasoning.

b. The Applicant properly traversed the unsupported statements, but the Examiner did not provide the required reference or affidavit in accordance with MPEP 2144.03.

c. The rejection fails to consider the disclosure as a whole.

The burden of establishing a prima facie case rests with the examiner. This burden is not satisfied by a mere list of

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1. See also 37 CFR 1.106(b); Chester v. Miller, 906 F.2d 1574, 1578, 15 USPQ2d 1333, 1337 (Fed. Cir. 1990) ("Section 132 is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection."). See also In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

terminology (e.g., Table-2 and Table-3).<sup>2</sup> Hence, the 35 USC 112-2 rejection must fall.

The Examiner must support '112-1 rejection with a proper explanation of why the disclosure is not adequate and must provide acceptable evidence or reasoning which supports a lack of adequate disclosure. In re Piasecki, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984). However, the '112-2 rejection does not provide a proper explanation and does not provide acceptable evidence or reasoning.

The Applicant developed his case with reasoning and evidence and traversed the Examiner's unsupported statements, but the Examiner did not provide a reference or an affidavit in support of his position as required by MPEP 2144.03. Further, these unsupported assertions are "in areas of esoteric technology" and hence should have been supported by a citation of a reference (MPEP 2144.03), but were not thusly supported.

Since the 35 USC 112-2 rejection does not establish a prima facie case, the 35 USC 112-2 rejection should be withdrawn. In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

Each claim must be evaluated individually to determine whether the individual claim meets the enablement requirement. In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Since the instant rejection does not establish a prima facie case, the '112-1 rejection should be withdrawn. In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

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2. In re Edwards, 568 F.2d 1349, 1354, 196 USPQ 465, 469 (CCPA 1978); In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

## 2.2 DOUBLE PATENTING REJECTIONS

### 2.2.1 Introduction

The Applicant respectfully traverses the double patenting rejections for the reasons of record and for the reasons set forth below.

### 2.2.2 The Double Patenting Rejections Do Not Establish

#### A Prima Facie Case

The double patenting rejections do not approach the specificity required to establish a prima facie case and to inform the Applicant of the nature of the rejections as required by 35 USC 132.<sup>3</sup>

Various examples of the non-specific and uninformative nature of the instant rejections are as follows.

a. The claims were not addressed individually, but were improperly rejected all together as a group of more than one thousand patent-copending claims.

b. Discussion of one claim does not establish double patenting for the other claims that are not compared.

c. Each of the instant claims has limitations that are **not found in any of the patent-copending claims**, but the limitations that the Examiner has addressed excludes most of the distinguishing limitations.

d. There are differences between the instant claims and the patent-copending claims, but the rejections do not properly address the differences.

e. The rejections do not even perform a proper one-way obviousness analysis and certainly do not perform the necessary two-way obviousness analysis.

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3. See also 37 CFR 1.106(b); Chester v. Miller, 906 F.2d 1574, 1578, 15 USPQ2d 1333, 1337 (Fed. Cir. 1990) ("Section 132 is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection."). See also In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

f. The Applicant properly traversed the Examiner's unsupported statements, but the Examiner did not provide the required reference or affidavit in accordance with MPEP 2144.03.

g. The Federal Circuit requires a limitation-by-limitation analysis, but the rejections do not even provide a claim-by-claim analysis (Section 2.4).

The burden of establishing a prima facie case rests with the examiner. This burden is not satisfied by addressing a few non-representative claims and ignoring claim differences.<sup>4</sup> Hence, the double patenting rejections must fall.

Each of the instant claims is rejected over more than a thousand patent-copending claims, but there is not a single proper claim comparison.

Each claim must be evaluated individually. In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The rejections do not properly acknowledge that different claims recite different combinations of features, much less compare these different combinations of features with the patent-copending claims.

Further, there are differences between the instant claims and the patent-copending claims. However, the rejections do not properly address these claim differences. For example, claim differences overcome a same invention-type double patenting rejection and claim differences must be evaluated using an obviousness analysis in an obviousness-type double patenting rejection infra. Therefore, ignoring the claim differences is fatal to the double patenting rejections.

The rejections do not provide the necessary two-way double patenting analysis. In re Braat, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991). Also see MPEP 804(B)(1)(b). A two-way

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4. In re Edwards, 568 F.2d 1349, 1354, 196 USPQ 465, 469 (CCPA 1978); In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

analysis is required because of the differences in the filing dates of the copending applications. Since a provisional double patenting rejection assumes that the copending applications are issued patents, a two-way double patenting analysis is required for the later filed copending applications which, as a result of the provisional nature of the instant rejection, must be treated as or at least presumed to be issued patents. Since the double patenting rejections do not address nor establish two-way double patenting, the double patenting rejections do not establish a prima facie case.

The Examiner selected a broader instant claim and a broader patent claim for discussion. Although such a discussion of a broader claim is easier and has the appearance of a better rejection, it does not establish a prima facie case of double patenting. The instant claim chosen by the Examiner is not representative of the other instant claims and is not representative of the instant claims having other types of patentable differences.

Addressing of broader allegedly representative claims does not establish a prima facie case with respect to the remainder of the claims. Also, addressing of only a very small percentage of the claim limitations does not establish a prima facie case with respect to the addressed claims and certainly not for the non-addressed claims nor for the remainder of the claim limitations. Each claim must be evaluated individually. In re Van Geuns supra.

The Applicant developed his case with reasoning and evidence and traversed the Examiner's unsupported statements, but the Examiner did not provide a reference or an affidavit in support of his position in violation of MPEP 2144.03. Further, these unsupported assertions are "in areas of esoteric technology" and hence should have been supported by a citation of a reference (MPEP 2144.03), but were not thusly supported.

Since the double patenting rejections do not establish a prima facie case, the double patenting rejections should be withdrawn. In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

### 2.2.3 The Same Invention-Type Double Patenting Rejections

#### 2.2.3.1 Introduction

The claims stand provisionally rejected under 35 USC 101 for same invention-type double patenting over claims of copending applications. The Applicant respectfully traverses these provisional rejections for the reasons of record, for the reasons set forth in Section 2.2.2, and for the reasons discussed below.

The requirement for same invention-type double patenting under 35 USC 101 is that the subject matter of the compared claims must be identical. In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970), In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Here, the subject matter of the compared claims is not even obvious (Section 2.2.4) and is certainly not identical.

Another requirement for a same invention-type double patenting rejection is an infringement test. For this infringement test, claim differences also overcome same invention-type double patenting.

#### 'OPINION

Since the rejection of claims 1, 3 and 5 was bottomed on 35 U.S.C. 101 and the test involves infringement, suffice it to say that claims 1, 3 and 5 include "an illumination source" while patent claims 28, 29 and 33 do not. Accordingly, the patent claims could be infringed without infringing claims 1, 3, and 5. This distinction alone is sufficient to defeat a double patenting rejection based on 35 U.S.C. 101.' (Ex parte Hyatt, unpublished decision of the PTO Board of Appeals, Appeal No. 480-93, Application S/N 874,444 decided October 13, 1983).

The instant claims have differences over the patent-copending claims.

Further, all of the instant claims are different from the claims of the copending applications. The rejection does not establish where the differences are recited in the copending-claims.

In view of the above, because there are differences between the instant claims and the patent-copending claims, the same invention-type double patenting rejections must fall.

#### 2.2.3.2 The Same Invention-Type Double Patenting Rejections Do Not Establish A Prima Facie Case

The same invention-type double patenting rejections do not establish a prima facie case for the reasons of record, for the reasons set forth in Section 2.2.2, and for the reasons discussed below.

There are differences between the instant claims and the patent-copending claims. However, a 35 USC 101 double patenting rejection requires the claimed subject matter to be identical. The instant claims are not even obvious over the patent-copending claims (Section 2.2.4) and are certainly not identical to the patent-copending claims. This lack of identical subject matter is fatal to the 35 USC 101 same invention-type double patenting rejections.

#### 2.2.4 The Obviousness-Type Double Patenting Rejections

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##### 2.2.4.1 Introduction

The claims stand rejected for obviousness-type double patenting. The Applicant respectfully traverses these rejections for the reasons of record and for the reasons discussed below.

#### 2.2.4.2 The Obviousness-Type Double Patenting Rejections Do Not Establish A Prima Facie Case

The obviousness-type double patenting rejections do not establish a prima facie case for the reasons of record, for the reasons set forth in Section 2.2.2, and for the reasons discussed below.

a. The rejections do not establish that the claim differences are obvious.

b. The rejections do not provide a Graham v. John Deere analysis as required for obviousness-type double patenting rejections.

c. The rejections do not provide a Gechter v. Davidson analysis (Section 2.4) as required for obviousness-type double patenting rejections.

Clearly, there are differences between the instant claims and the patent-copending claims. See the amendments to the claims herein. However, the double patenting rejections do not establish that these differences are obvious.

There are differences between the instant claims and the patent-copending claims. Hence, to support an obviousness-type double patenting rejection, it is incumbent upon the Examiner to establish that the differences are obvious. In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). However, the rejections fail to establish that the differences are obvious.

An obviousness-type double patenting rejection is analogous to an obviousness rejection under 35 USC 103. In re Braithwaite, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Thus, a prima facie case of obviousness-type double patenting must be established in the same manner that it is required for a rejection under 35 USC 103. In re Longi. Accordingly, the factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966) must be employed when making an obviousness-type double patenting analysis.

## 2.2.5 The Nonobviousness-Type (Schneller-Type) Double Patenting Rejections

### 2.2.5.1 Introduction

The long established law of double patenting is clear and requires a two-part test. The first test is for same invention-type double patenting. The second test is for obviousness-type double patenting. If a claim passes both tests "there is no double patenting." In re Vogel, 422 F.2d 438, 442, 164 USPQ 619, 622 (CCPA 1970).

The Schneller-type double patenting rejections do not attempt to establish a prima facie case of double patenting under either the first test, same invention-type double patenting, or the second test, obviousness-type double patenting. Instead, the Examiner seeks to change the long established black letter law of double patenting by applying an ill defined third test for double patenting that is based upon In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968) that has been superseded by In re Vogel. The Applicant demonstrates below (1) that Schneller supra does not represent the law and (2) that the present claims satisfy the Schneller supra test.

### 2.2.5.2 A Two-Part Test For Double Patenting Has Been Established By In Re Vogel

The two-part test for double patenting as it exists today was enunciated by the CCPA in the en banc decision of In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970) and adopted by the Federal Circuit in In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Vogel expressly restated the controlling law of double patenting and thereby laid the foundation for the law of double patenting as it exists today. The Court stated,

The proceedings below in this case indicate the advisability of a restatement of the law of double patenting as enunciated by this court.

In re Vogel, 422 F.2d 438, 442, 164 USPQ 619, 621 (CCPA 1970).

In the Federal Circuit, the judges usually sit as a three judge panel and earlier decisions are given precedence over later decisions except when a decision is rendered en banc. However, all CCPA cases, including In re Vogel, were rendered en banc and later decisions therefore took precedence over earlier decisions. Later decisions sub silentio overruled any prior decisions to the extent that a prior decision was inconsistent with a later decision. As stated by the Federal Circuit,

To the extent that [the later decision] language is inconsistent with that in [earlier decisions], that inconsistency has already been sub silentio removed. The CCPA's later decisions control because that court always sat en banc. In re Gosteli, 872 F.2d 1008, 1011, 10 USPQ2d 1614, 1617 (Fed. Cir. 1989).

Vogel's two-part test for double patenting thus became controlling law and sub silentio overruled any prior CCPA decisions, including Schneller supra, that were inconsistent with the two-part test. The first part of the test was defined as follows,

The first question in the analysis is: Is the same invention being claimed twice? ... By "same invention" we mean identical subject matter.

422 F.2d 438, 441, 164 USPQ 619, 621 (CCPA 1970).

The Court explained that a patent cannot be granted, whether or not a terminal disclaimer is filed, if the same invention is being claimed. However, if the same invention is not being claimed, a second test must be considered.

The second analysis question is: Does any claim in the application define merely an obvious variation of an invention disclosed and claimed in the patent?

422 F.2d 438, 442, 164 USPQ 619, 622 (CCPA 1970).

The conclusions to be drawn from the tests were stated as follows,

If the answer to the second question is no, there is no double patenting involved and no terminal disclaimer need be filed. If the answer is yes, a terminal disclaimer is required to prevent undue timewise extension of monopoly. [Emphasis added.]

422 F.2d 438, 442, 164 USPQ 619, 622 (CCPA 1970).

Since the third test for double patenting used in Schneller supra is wholly inconsistent with the two-part test enunciated in Vogel, Schneller is necessarily overruled by Vogel and therefore cannot be applied by the PTO.

The two-part test for double patenting has been consistently followed by subsequent CCPA and Federal Circuit decisions. For example, in the case of In re Avery, 518 F.2d 1228, 186 USPQ 161 (CCPA 1975), the CCPA expressly recognized the restatement of the law of double patenting by In re Vogel and applied the two-part double patenting test of Vogel. The Court reached the decision that there was no same invention double patenting under the first test but that there was obviousness double patenting under the second test.

The Federal Circuit adopted the Vogel two-part test for double patenting in In re Longi, stating,

A double patenting rejection precludes one person from obtaining more than one valid patent for either (a) the "same invention," or (b) an "obvious" modification of the same invention.

In re Longi, 759 F.2d 887, 225 USPQ 645, 648 (Fed. Cir. 1985). The two-part test was later affirmed by In re Braat, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991).

The Schneller-type double patenting rejections are neither (1) same invention-type double patenting nor (2) obviousness-type double patenting. The Schneller-type double patenting rejections thus fail to establish a prima facie case of double patenting. Any rejection that relies on the earlier case of In re Schneller supra to justify a third "nonobviousness" test for double patenting must be withdrawn.

#### 2.2.5.3 The Examiner Should Not Ignore In re Vogel

##### By Creating A Third Test For Double Patenting

The instant rejection seeks to add a third "nonobviousness" test to the two-part test that was established by the en banc Vogel decision and later adopted by the Federal Circuit in In re Longi. In particular, the instant rejection seeks to reinstate In re Schneller supra. Schneller supra was a bad decision which was mercifully overruled sub silentio when the en banc decision in Vogel restated the law of double patenting. Schneller supra should not be resurrected some 27 years after its timely demise.

In re Vogel expressly defines a two-part test for double patenting and then states if "the answer to the second question is no, there is no double patenting involved and no terminal disclaimer need be filed." [emphasis added] 422 F.2d at 442, 164 USPQ at 622. To add a third, Schneller, test for double patenting as asserted in the instant rejection would thus require the Examiner to ignore the controlling law as enunciated in In re Vogel and the subsequent Federal Circuit cases defining a two-part test for double patenting.

#### 2.2.5.4 The Present Claims Satisfy The Overruled Schneller Inquiries For Double Patenting

Even if one were to consider that the controlling law of In re Vogel should be ignored and a third, Schneller, test for patentability should be applied, the present claims fully satisfy such a third test. In addition to the absence of any legal basis for the test, the Applicant traverses the rejections based upon Schneller supra for double patenting for the following reasons.

1. The rejections fail to establish a prima facie case of Schneller-type double patenting (Section 2.2.5.5).
2. The instant claims are independent or distinct from all of the patent claims (Section 2.2.5.8).

3. Schneller supra is limited to cases where a patent and an application claim the same preferred embodiment, which does not apply to the present case (Section 2.2.5.6).

4. The facts in the instant application are distinguishable from the Schneller facts (Section 2.2.5.7).

Any one of these reasons is sufficient reason for reversing the double patenting rejections; the combination of all of these reasons represent overwhelming grounds for reversal.

#### 2.2.5.5 The Nonobviousness-Type Double Patenting Rejections Do Not Establish A Prima Facie Case

For the reasons discussed in Section 2.2.2 and for the additional reasons discussed below, the nonobviousness-type double patenting rejections do not establish a prima facie case.

1. The rejections do not properly address independence or distinctness of the claims.

2. The rejections improperly rely on unsupported conclusionary contentions.

3. The rejections ignore limitations recited in the body of the claims.

The instant claims are independent or distinct from the patent claims. Hence, Schneller-type double patenting does not apply. 397 F.2d at 354, 158 USPQ at 214.

The rejections improperly rely on conclusionary, unsupported contentions infra.

The rejections allege that the instant claims are "covered" by the patent claims patent and the instant application are claiming common subject matter. The rejections establish that there are differences between the compared claims. However, the rejections do not properly address the differences. Clearly, the Examiner has not provided any support for the contention that the

instant claims are "covered" by the claims of the patent applications.

The rejections do not even attempt to establish what is covered by the patent claims; the rejections do not attempt to explain why the instant claims are held to be covered by the patent claims, which have different limitations; and the rejections do not attempt to explain how the systems claimed in the patent can "cover" the significantly different system claimed in the instant application. This reason alone is sufficient to show that the rejections do not establish a prima facie case.

Further, the rejections ignore the limitations recited in the body of the claims. The instant claim limitations are not recited in the patent claims. The instant claims recite combinations of these limitations. Clearly, a proper analysis of the instant claims and the patent claims confirms that there is no double patenting.

The rejections state that, since the instant claims are fully disclosed in the patent, the patent and the instant application are claiming common subject matter. This is not correct. Claiming of common subject matter can only be determined by comparing the claims of the patent with the claims of the application, but clearly the claimed subject matter has significant differences. Disclosed but unclaimed inventions in the instant application are irrelevant to double patenting.

Because the rejections do not establish a prima facie case, the Schneller supra "nonobviousness" double patenting rejections should be withdrawn. In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

2.2.5.6 Schneller Only Applies Where The Patent Claims And The Application Claims Are Directed To The Same Preferred Embodiment

Schneller supra double patenting is limited to use where a patent and an application both claim the same preferred

embodiment or the same best mode. This is in direct contrast to the present application.

Schneller double patenting is specifically applied to "patent protection on the preferred embodiment of the invention, ABCXY". [emphasis added] 397 F.2d at 355, 158 USPQ at 215. Also see 397 F.2d at 354, 158 USPQ at 215 ([The patent claims] "cover" the preferred form ABCXY common to the patent and this application') [emphasis added]; 397 F.2d at 356, 158 USPQ at 216 ("Anyone attempting to utilize what he disclosed in the patent \* \* \* in the preferred and only form in which he described these clips, would thus run afoul of a still unexpired patent if the application claims were allowed.") [emphasis in original]; 397 F.2d at 355, 158 USPQ at 216 ("the greatest advantage and best mode of practicing the invention as disclosed is obtained by using both inventions in the combination ABCXY.") [emphasis added] Schneller even admitted that the preferred embodiment ABCXY was the "best mode" of practicing his invention. 397 F.2d at 354, 158 USPQ at 214.

In further contrast to Schneller supra, the disclosures in the instant application and in the patent are extensive and recite many different features, inventions, and alternate embodiments. The different inventions claimed in the instant application and in the patent are not disclosed as being component parts of the same preferred embodiment. Numerous different embodiments are disclosed. Also, the disclosure has many different implementations. In contrast, Schneller supra has only two sheets of drawings and only six columns of specification which are indicated to be directed to a single preferred embodiment.

Not surprising, the Examiner does not contend that the patent claims are directed to the same specific type of system recited in the instant claims nor that the instant claims and the patent claims cover a single preferred embodiment. They, in fact, are not directed to the same type of system and do not

cover a single preferred embodiment supra. For these reasons alone, the nonobviousness-type double patenting rejections should be withdrawn.

#### 2.2.5.7 The Facts In The Instant Application Are Significantly Different From The Facts Of Schneller

##### 2.2.5.7.1 Introduction

Schneller is a very narrow fact-specific decision. The Court in Schneller stated:

Once more we "caution again against the tendency 'to freeze into rules of general application what, at best, are statements applicable to particular fact situations'." In re Riden, 50 CCPA 1411, 1415, 318 F.2d 761, 763, 138 USPQ 112, 114. (397 F.2d at 355, 158 USPQ at 215)

Schneller supra itself is a very specific fact sensitive and fact intensive case that must be very narrowly construed. See Section 2.2.5.6 entitled Schneller Only Applies Where The Patent Claims And The Application Claims Are Directed To The Same Preferred Embodiment. Also see Sections 2.2.5.7.2 to 2.2.5.7.5.

The PTO acknowledges that Schneller-type double patenting rejections are only appropriate in certain rare and unique circumstances. According to the MPEP:

"There are some unique circumstances where it has been recognized that another type of nonstatutory double patenting rejection is applicable even where the inventions claimed in two or more applications/patent are considered nonobvious over each other. These circumstances are illustrated by the facts before the court in In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). [emphasis added] MPEP 804

The facts surrounding the instant application are vastly different from the facts in Schneller supra. As such, the "unique circumstances" surrounding Schneller supra are not present and the nonobviousness-type double patenting rejections based on Schneller supra are inappropriate. For example:

1. the Schneller inventions involve multiple bends in the same piece of wire while the present inventions are different combinations of different elements in different types of systems (Section 2.2.5.7.2);

2. in contrast to Schneller, the application claims are independent or distinct from the patent claims;

3. in contrast to Schneller, the instant application has ample justification for separate patent (Section 2.2.5.7.3);

4. in contrast to Schneller, the instant claims are not "covered" by the patent claims (Section 2.2.5.7.4); and

5. in contrast to Schneller, the disclosures in the instant application and in the patent are significantly different.

#### 2.2.5.7.2 Schneller's Invention Is A Unitary Device,

##### A Single Piece Of Wire Having Five Bends

In Schneller supra, the applicant disclosed a single invention, a single unitary bent wire forming a clip. The invention was in the bends in the wire. The same preferred embodiment was claimed in the patent and was also claimed in the application (Section 2.2.5.6). Hence, additional claims in a second patent would extend Schneller's patent rights over the same preferred embodiment.

Conversely, the patent as well as the instant application disclose plural preferred embodiments (Section 2.2.5.6).

The facts in the instant application are thus very different from Schneller supra. In Schneller supra, a person practicing the only disclosed embodiment of the invention would infringe both the patent claims as well as the application claims. Thus, allowance of the application claims without a terminal disclaimer would extend the patent coverage of the only disclosed embodiment beyond 17 years, creating a so-called "unjustified timewise extension." Conversely, in the instant application a person

could practice a disclosed embodiment without necessarily infringing both the instant claims and the claims of the patent. This is because of the multiple disclosed embodiments. This is also because the claims are independent or distinct. Thus, because of the disclosure of multiple embodiments and because the claims are independent or distinct in the present case, there is no timewise -- let alone an unjustified timewise -- extension of patent rights.

#### 2.2.5.7.3 The Present Case Has Ample Justification For Multiple Applications

In contrast to Schneller supra, the filing of the instant continuing application is justified. In Schneller supra, the Court several times expressed concern for a lack of any justification for the multiple applications. See, 397 F.2d at 353, 158 USPQ at 214 ("There is, therefore, no direct indication before us why appellant chose this voluntary division method of claiming"); 397 F.2d at 355, 158 USPQ at 215 ("Neither do we have any requirement of restriction"). However, in contrast to Schneller supra, the present application has ample justification for the multiple patent applications.

First, the instant claims are independent or distinct from the patent claims. Hence, presentation of the instant claims in the other applications would likely have resulted in a restriction requirement.

Second, the patent and the application in Schneller supra have few claims while the patent and the instant application in the present case have many claims. The Schneller supra patent and application have only 5 claims and 7 claims, respectively. In view of the claims being directed to independent or distinct inventions, it is almost certain that examiners in the other applications would have objected to such a number of claims in the same application. In contrast, it is submitted that, in Schneller supra, the CCPA considered the grouping of the 5 patent

claims and the 7 application claims into a single application to be a reasonable grouping.

Thus, in contrast to Schneller supra, there is ample justification for not grouping the instant claims with the patent claims.

2.2.5.7.4 The Claims In The Instant Application .

Are Not "Covered" By The Patent Claims

The term "cover" in Schneller supra involves claiming the same preferred embodiment. The patent claims '"cover" the preferred form ABCXY common to the patent and this application'. See In re Schneller, 397 F.2d at 354, 158 USPQ at 215. In Schneller supra, the patent claims and the application claims were found to be directed to the "best mode" (the single preferred embodiment). 397 F.2d at 354, 158 USPQ at 214. This does not apply in the present case because the instant application and the patent disclose numerous alternate embodiments. The CCPA did not offer any comments to suggest that the facts of Schneller supra could be broadened to the facts which exist in the instant application.

In Schneller supra, a product infringing the preferred embodiment ABCXY must infringe both, the application claims and the patent claims. This is far from the present case. In the present case, the instant claims and the patent claims are not directed to a common preferred embodiment, hence the instant claims are not covered by the patent claims. The instant claims are independent or distinct from the patent claims. Hence, no form of double patenting, certainly not nonobviousness-type double patenting, applies to the present case.

#### 2.2.5.8 Schneller Is Distinguished Pursuant To In re Heinle

The Schneller decision distinguished In re Heinle, 342 F.2d 1001, 145 USPQ 131 (CCPA 1965) on the basis of distinctness because the combinations of the patent claims and the application claims in Heinle were "separately usable and salable" while the Schneller device was not separately salable and usable. As stated in Schneller, 397 F.2d at 355, 158 USPQ at 215:

The issued patent [in Heinle] claimed a mechanical combination for holding a toilet paper roll. The application claimed a separately usable and salable element of that combination, a particular core for the roll. A combination claim does not "cover" or read on a single element. The protection of the combination afforded by the single Heinle patent claim would not have been extended by the application claims directed to the element. Id. (emphasis in original removed, emphasis added). 397 F.2d at 355, 158 USPQ at 215

As in Heinle, the system of the instant claims and the systems of the patent claims are combination claims that are "separately usable and salable". The instant claims are therefore independent or distinct from the patent claims and hence distinguish Schneller.

#### 2.2.5.9 Conclusion

The law of double patenting requires a two-part test. This well-established law should not be changed by ignoring In re Vogel and adding a third, Schneller, test for double patenting. However, the present claims would clearly satisfy a Schneller test for double patenting even if the Schneller test were to be added to the existing law. The instant rejection, moreover, does not establish a prima facie case for double patenting under a Schneller analysis or any other analysis. Thus, it is respectfully requested that the nonobviousness-type double patenting rejections be withdrawn.

## 2.3 35 USC 102 AND 35 USC 103 REJECTIONS

### 2.3.1 Introduction

The Applicant respectfully traverses the 35 USC 102 and 35 USC 103 rejections for the reasons of record and for the reasons set forth below.

### 2.3.2 The Rejections Do Not Establish A Prima Facie Case

The 35 USC 102 and 35 USC 103 rejections do not approach the specificity required to establish a prima facie case and to inform the Applicant of the nature of the rejections as required by 35 USC 132.<sup>5</sup>

Various examples of the non-specific and uninformative nature of the instant rejections are as follows.

a. The instant claims are not addressed individually.

b. Each of the instant claims has limitations that are not met by the references.

c. The claim discussions show differences between the instant claims and the references, the Examiner admits to differences, but the rejections do not properly address the differences.

d. The Applicant properly traversed the Examiner's unsupported statements, but the Examiner failed to provide the required reference or affidavit in accordance with MPEP 2144.03.

e. The Federal Circuit requires a limitation-by-limitation analysis, but the rejections do not even provide a claim-by-claim analysis (Section 2.4).

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5. See also 37 CFR 1.106(b); Chester v. Miller, 906 F.2d 1574, 1578, 15 USPQ2d 1333, 1337 (Fed. Cir. 1990) ("Section 132 is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection."). See also In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

The burden of establishing a prima facie case rests with the examiner. This burden is not satisfied by addressing non-representative claims and ignoring claim differences.<sup>6</sup> Hence, the 35 USC 102 and 35 USC 103 rejections must fall.

Each claim must be evaluated individually. In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The rejections do not properly acknowledge that different claims recite different combinations of features, much less address these different combinations of features relative to the references.

Further, the rejection shows differences between the instant claims and the references. However, the rejections do not properly address these claim differences.

Addressing of broader claims does not establish a prima facie case with respect to the remainder of the claims. Also, addressing only a small percentage of the claim limitations does not establish a prima facie case with respect to the addressed claims and certainly not for the non-addressed claims nor for the remainder of the claim limitations. Each claim must be evaluated individually. In re Van Geuns supra.

The Applicant developed his case with reasoning and evidence and traversed the Examiner's unsupported statements, but the Examiner did not provide a reference or an affidavit in support of his position in violation of MPEP 2144.03. Further, these unsupported assertions are "in areas of esoteric technology" and hence should have been supported by a citation of a reference (MPEP 2144.03), but were not thusly supported.

Since the double patenting rejections do not establish a prima facie case, the double patenting rejections should be withdrawn. In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

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6. In re Edwards, 568 F.2d 1349, 1354, 196 USPQ 465, 469 (CCPA 1978); In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

2.4 THE FEDERAL CIRCUIT REQUIRES A LIMITATION-BY-LIMITATION ANALYSIS, BUT THE REJECTIONS DO NOT EVEN PROVIDE A CLAIM-BY-CLAIM ANALYSIS

The Federal Circuit requires that rejections be supported on a limitation by limitation basis with specific fact findings for each contested limitation and satisfactory explanations for such findings. The claim construction used in contesting the limitations **must** also be explicit. The Federal Circuit also **requires** fact findings, adequately explained, for each relevant factor. See Gechter v. Davidson, 43 USPQ2d 1031 at 1035 (Fed. Cir. 1997). However, the double patenting rejections fail to meet these requirements. **The rejections do not even provide a claim-by-claim analysis, much less a limitation-by-limitation analysis.** In violation of Gechter v. Davidson supra, the rejections disregard important claim limitations

Gechter v. Davidson supra followed closely on the heels of Warner-Jenkinson Co. v. Hilton Davis Chemical Co., 117 S.Ct. 1040, 41 USPQ2d 1865 (1997) where the Supreme Court affirmed the requirement for an element by element analysis in defining the scope of a patented invention in infringement analyses.

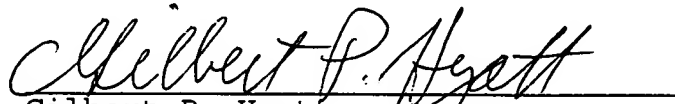
Gechter v. Davidson supra addresses 35 USC 102 and 35 USC 103 rejections (Section 2.3). However, it is well-established that an obviousness-type double patenting rejection requires the same type of obviousness analysis as a 35 USC 103 obviousness rejection (Section 2.2). Similarly, a same invention-type double patenting rejection requires the same type of identity analysis as a 35 USC 102 anticipation rejection (Section 2.2). Hence, Gechter v. Davidson supra is equally relevant to these two types of double patenting rejections.

In contradiction to Gechter v. Davidson supra, the 35 USC 102 and 35 USC 103 rejections and the double patenting rejections do not provide the required limitation by limitation analysis and do not provide the required adequately explained fact findings for each relevant factor. For this additional reason, the art rejections and the double patenting rejections fail to establish a prima facie case.

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Respectfully submitted,

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